

REMARKS

The indication that claims 18 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged. By the present amendment, claim 18 has been written in independent form while clarifying features whereas claim 22 which depends from claim 16 has been retained in dependent form since applicants submit that parent claim 16 should now be in condition for allowance, as will be discussed below.

Applicants note that although claims 6-14, 19-21 and 25 are indicated as withdrawn from consideration, applicants submit that some of the withdrawn claims depend from claims which are considered to be allowable and such claims should be considered at this time, as will be discussed below.

The rejection of claims 1-3, 15-17, 23 and 26-27 under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al (5,870,075) and the rejection of claims 4 and 5 under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al and further in view of Applicant's Admitted Prior Art (AAPA), such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or

suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In applying Yamazaki et al to the claimed invention, the Examiner states:

Yamazaki further discloses the first and second pixel electrode (101 and 102) are disposed on the first substrate (see Figs. 2A and 2B), and the other pixel electrodes (112 and 113) are disposed on the second substrate (see Figs. 2A and 2B).

The Examiner further states:

Yamazaki does not call the other pixel electrodes (112 and 113) as common electrodes. However, in Fig. 10, Yamazaki discloses a pixel electrode of a pixel (1012) is connected to a switch (1007), and the other pixel electrode of the pixel (1012) is commonly connected to

the ground, which is commonly known as a common electrode. Since the pixel electrodes (112 and 113) are equivalent to the other pixel electrode of the pixel (1012), it would have been obvious to one ordinary skill in the art that the pixel electrodes (112 and 113) are equivalent to a common electrode. (emphasis added)

Applicants submit that the Examiner has mischaracterized the disclosure of Yamazaki et al in relation to Fig. 10. More particularly, col. 1, lines 44-47 of Yamazaki et al provide that "Drain electrodes of the TFTs 1007-1010 are connected to retaining capacitors 1016-1019 and pixel electrodes (not shown) provided for respective liquid crystal cells 1012-1015 of pixel regions." (emphasis added) Thus, applicants submit that it is not seen that Fig. 10 and the corresponding description in Yamazaki et al provide the features as contended to be obvious by the Examiner. Additionally, applicants note that the first and second pixel electrodes 101 and 102 of Figs. 2A and 2B of Yamazaki et al represent a central pixel electrode 101 and a peripheral pixel electrode 102 as illustrated in Fig. 1 of Yamazaki et al which are formed on a transparent substrate 110 and a central pixel electrode 112 opposite to the electrode 101 and a peripheral pixel electrode 113 opposite to the peripheral pixel electrode 102 are formed on a transparent substrate 111 as described at col. 9, lines 22-28 and Figs. 2A and 2B of Yamazaki et al.

By the present amendment, claim 16 has been written in independent form incorporating the features of parent claims 1 and 15 therein, while clarifying the feature that the first and second pixel electrodes are disposed on said first substrate, and said common electrode is disposed on one of said first substrate and said second substrate noting that in Fig. 22, which is representative of the elected species, has the first pixel electrode 4 and the second pixel electrode 5 being disposed on the substrate 1 and the common electrode 3 disposed on the second substrate 2. It is noted, however, as illustrated in Fig. 18A, the common electrode 3 may be disposed on the first substrate 1, and by the present amendment, claim 16 has been amended to provide for either disposition. As further recited in claim 16,

said common electrode overlaps said first and second pixel electrodes which is clearly illustrated in Figs. 22 and 18A, for example.

Assuming arguendo that in Figs. 2A and 2B of Yamazaki et al that the electrode 112 or the electrode 113 may be considered a common electrode, it is readily apparent that the electrode 112 does not additionally overlap with the pixel electrode 102 and likewise, the electrode 113 does not additionally overlap with the pixel electrode 101, as recited in claim 16. Thus, applicants submit that Yamazaki et al does not disclose or teach in the sense of 35 U.S.C. 103 the recited features of claim 16 which has been written in independent form and recites "said common electrode overlaps said first and second pixel electrodes" (emphasis added), such that claim 16 and the dependent claims thereof patentably distinguish over Yamazaki et al and should be considered allowable thereover.

Applicants note that claim 17 has been amended to depend from claim 16 and recites further features, which when considered in conjunction with parent claim 16 further patentably distinguish over the cited art and should now be in condition for allowance.

With respect to claim 5 which has also been written in independent form by the present amendment, such claim recites the feature that the first pixel electrode and the common electrode are linear and are arranged substantially in parallel, and that the second pixel electrode is located between the first pixel electrode and the common electrode. The Examiner recognizes that "Yamazaki fails to disclose disposing the pixel electrodes and the common electrodes on the first substrate". The Examiner contends that AAPA disclose, in the same display field, disposing pixel electrodes and common electrodes on a first substrate (1, Fig. 2), with the Examiner contending that in light of AAPA, it would have been obvious to one ordinary skill in the art to disposing Yamazaki's pixel electrodes and common electrodes on the first substrate because this arrangement provides a larger angle of

visibility. Applicants note that AAPA as represented by Fig. 2 of the drawings of this application only discloses that first pixel electrodes 4 and common electrodes 3 are disposed on a first substrate 1 as is provided in a conventional IPS mode which is different from the vertical electric field arrangement of Yamazaki et al. In any event, assuming arguendo that the combination as suggested by the Examiner could be made, there is no disclosure or teaching to provide the structural arrangement as recited in claim 5 that said second pixel electrode is located between said first pixel electrode and said common electrode. Thus, applicants submit that neither Yamazaki et al nor AAPA disclose or teach the aforementioned recited feature of claim 5 and that any suggested modification to provide such feature represents a hindsight reconstruction attempt utilizing the principle of "obvious to try" which is not the standard of 35 U.S.C. 103 (see In re Fine, supra), and that could only come about by utilizing the teachings of the inventor against him which is not proper (see In re Lee, supra). Thus, applicants submit that claim 5 and its dependent claims recite features not disclosed or taught in the cited art so as to patentably distinguish thereover and claim 5 and the dependent claims should be considered allowable at this time.

Applicants note that by the present amendment, claims 2, 3, 23 and 24 have been amended to depend from claim 5 such that these claims which recite further features of the present invention, should be considered allowable with parent claim 5. In this regard, it is noted that claim 26 under consideration depends from claim 24 which depends from claim 5 and also should be considered allowable at this time. Applicants note that of the claims which stand withdrawn from consideration, claims 13 and 19 depend directly from claim 5 and should be considered allowable therewith. Also, claim 14 which depends from claim 13 and claim 25 which depends from claim 24 should also be given consideration at this time and deemed allowable with its parent claims.

Also, by the present amendment, claim 27 has been amended to incorporate the features of claims 4 and 5 therein while clarifying other features of such claim and as pointed out above, the cited art does not disclose or teach the feature of claim 5 now incorporated into claim 27 of the second pixel electrode being located between the first pixel electrode and the common electrode. Thus, applicants submit that claim 27 should also be considered allowable at this time.

Applicants further note that in rewriting claim 18 in independent form so as to place this claim in condition for allowance, the claim has been amended to recite the feature that said common electrode is disposed on said second substrate.

For the foregoing reasons, applicants submit that all claims previously under consideration or which should be under consideration based upon the amendment herein, claims 2, 3, 5, 13, 14, 16-19 and 22-27 patentably distinguish over the cited art and should now be in condition for allowance, so that an action of a favorable nature with respect to the aforementioned claims is respectfully requested.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.40571X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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